



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,698	06/26/2003	Nadia Gardel	05725.1213-00	8001

7590 08/05/2009
Thomas L. Irving
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.
1300 I Street, N.W.
Washington, DC 20005-3315

EXAMINER

MCMILLIAN, KARA RENITA

ART UNIT	PAPER NUMBER
----------	--------------

1617

MAIL DATE	DELIVERY MODE
-----------	---------------

08/05/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/603,698	Applicant(s) GARDEL ET AL.	
	Examiner KARA R. MCMILLIAN	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 19-99 is/are pending in the application.
- 4a) Of the above claim(s) 2-16 and 96-99 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 17, 19-95 and 99 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4-29-09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendments/Arguments

No amendments to the claims were made. As such claims 1, 17, 19-95 and 99 are presented for examination.

Applicants have pointed out that claim 99 was inadvertently indicated in the previous office action as withdrawn. Claim 99 should not be withdrawn and is included in the rejections below. Please note that claim 99 is incorrectly labeled as withdrawn in the claims submitted on February 12, 2008.

Applicant's arguments filed April 29, 2009 with respect to the rejection under nonstatutory double patenting have been fully considered but they are not persuasive.

Applicants argue that since the present application is the earlier filed of the copending application and Applicants have overcome the other grounds of rejections, the provisional double patenting rejection should be withdrawn so as to comply with MPEP 804(I)(B)(1). This argument is found not persuasive since Applicants have not overcome all other grounds of rejections and the double patenting rejection is not the only remaining rejection. As such said rejection is maintained and reproduced below.

Applicant's arguments filed April 29, 2009 with respect to the rejection under 35 USC 103 have been fully considered but they are not persuasive.

The applicants maintain that the examiner has failed to establish a prima facie case of obviousness because Hanna et al. fail to teach or suggest all the elements of

Art Unit: 1617

the present claims. Specifically, the applicants assert that Hanna et al. do not teach the specific combination of a C₈-C₂₂ alkyl dimethicone copolyol and another dimethicone copolyol as presently claimed in instant claim 1 in the percentages indicated. This argument is found not persuasive since Hanna et al. teach that the W/O emulsions preferably contain one or more surfactants to stabilize the emulsion and examples of the oil surfactant include dimethicone copolyol, the C₈-C₂₂ alkyl dimethicone copolyol, cetyl dimethicone copolyol, etc. (see column 4 lines 56-57 and column 5 lines 3-6). Furthermore, Hanna et al. teach that of course, mixtures of useful oil surfactants may be used (see column 5 lines 6-7). Hanna et al. also teach that the amount of oil surfactant useful in the W/O emulsion is from 5-15 wt. %. As such Hanna et al. meet the limitations of instant claim 1 since Hanna et al. teach that mixtures of oil surfactants (e.g. dimethicone copolyol and cetyl dimethicone copolyol) are useful and that the amount of oil surfactant is between 5 and 15 wt. %. As such, dimethicone copolyol and cetyl dimethicone copolyol can be added up to 15 wt. % which could be 5% dimethicone copolyol and 5% cetyl dimethicone copolyol or 10% dimethicone copolyol and 5% cetyl dimethicone copolyol, etc. It has been held that it is within the skill in the art to select optimal parameters, such as amounts of ingredients, in a composition in order to achieve a beneficial effect. See *In re Boesch*, 205 USPQ 215 (CCPA 1980). Furthermore, it is obvious to vary and/or optimize the amount of ingredients provided in the composition, according to the guidance provided by Hanna et al. to provide a composition having the desired properties such as the desired ratios, concentrations, percentages, etc. It is noted that “[W]here the general conditions of a claim are

Art Unit: 1617

disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

Applicants argue that the declaration submitted by Ozee Emmanuelle showing that the claimed foundation has unexpected superiority shows a direct comparison between Applicants claimed invention and the invention of Hanna et al. Applicants state that the examiner was not persuaded by the data submitted in the declaration because the Examiner does not believe that the declaration provides a direct comparison between the claimed invention and the invention disclosed in Hanna. The Examiner did not state in the previous office action that the data was not persuasive because a direct comparison was not disclosed.

It is the Examiners position that Hanna et al. teach concentrations of the oil surfactant that lie within the range claimed in the instant application. Hanna et al. teach that the W/O emulsions preferably contain one or more surfactants to stabilize the emulsion and examples of the oil surfactant include dimethicone copolyol, the C₈-C₂₂ alkyl dimethicone copolyol, cetyl dimethicone copolyol, etc. (see column 4 lines 56-57 and column 5 lines 3-6). Hanna et al. teach that of course, mixtures of useful oil surfactants may be used (see column 5 lines 6-7). Hanna et al. also teach that the amount of oil surfactant useful in the W/O emulsion is from 5-15 wt. %. As such Hanna et al. meet the limitations of instant claim 1 since Hanna et al. teach that mixtures of oil surfactants (e.g. dimethicone copolyol and cetyl dimethicone copolyol) are useful and that the amount of oil surfactant is between 5 and 15 wt. %. As such, dimethicone

Art Unit: 1617

copolyol and cetyl dimethicone copolyol can be added up to 15 wt. % which could be 5% dimethicone copolyol and 5% cetyl dimethicone copolyol or 10% dimethicone copolyol and 5% cetyl dimethicone copolyol, etc.

Furthermore, the Examiner stated that while the submitted data indicate the claimed foundation is more stable than other foundations that are outside the 5-10% range, the results are not viewed as unexpected results since Hanna et al. teach that W/O emulsions preferably contain one or more surfactants to stabilize the emulsion. Furthermore, Hanna et al. teach that the oil surfactant which can be dimethicone copolyol is preferably present from 8-10 wt. % (see column 5 line 31). Based on the prior art, one of ordinary skill in the art would be motivated to use the range taught in Hanna et al. to obtain a stable W/O emulsion. As such, Applicant's observed results are not unexpected and the claimed W/O emulsion would be expected to have improved stability based on the knowledge and teachings of the prior art (Hanna et al.).

Applicants further argue that since Hanna et al. fail to teach or suggest all the limitations of the present claims, Elm et al. or Bara et al. do not and cannot cure the deficiencies of Hanna et al. already set forth. This argument is found not persuasive since Hanna et al. renders obvious the claims of the instant application as discussed above.

For the reasons stated above and for the reasons of record the 103(a) rejections of the last office action are maintained and the rejections are reproduced below.

This action is made FINAL.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 17, 19-95 and 99 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 80-83, 86-93, 97-100, 104-186 of copending Application No. 10/784,909 (copending ‘909). Although the conflicting claims are not identical, they are not patentably distinct from each other because the cited claims of the instant application and the copending ‘909 are substantially overlapping in scope and mutually obvious.

Both copending applications are directed to a water-in-oil foundation comprising at least one oil, an aqueous phase, a copolyol and a coloring material. The difference between the instant invention and the copending application is the weight percentages and concentrations of the components. This determination would have been made through routine experimentation to achieve the desired results of the claimed invention.

Art Unit: 1617

This is in the absence of any clear showing of unexpected results attributable to the specific concentrations of the components employed by applicant in the instant case.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1, 17, 19-95 and 99 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-41 of copending Application No. 10/849,825 (copending '825) in view of Bara (U.S. Patent No. 5,919,468). Although the conflicting claims are not identical, they are not patentably distinct from each other because the cited claims of the instant application and the copending '825 are substantially overlapping in scope and mutually obvious.

Both copending applications are directed to a water-in-oil emulsion comprising a fatty phase, an aqueous phase, a dimethicone copolyol, and a C₈-C₂₂ alkyl dimethicone copolyol and volatile hydrocarbon oils. The difference between the instant invention and the copending application is that the emulsion of copending '825 contains an additional ingredient, polymethyl methacrylate. Claims 89-92 of the instant application claim the addition of at least one filler such as talc, mica, silica, polyethylene powders, etc., but do not teach polymethyl methacrylate as a suitable species of a filler.

Bara teaches that the addition of fillers including silica, polyethylene powder, poly methyl methacrylate, etc. modifies the texture of the formulation (see column 3 line 66 to column 4 line 5). It would be obvious to one of ordinary skill in the art to add any suitable filler known in the art to the emulsion of the instant application in order to

Art Unit: 1617

modify the texture of the formulation. An ordinary skilled artisan would be motivated to choose polymethyl methacrylate as a suitable filler with a reasonable expectation of similar success as said filler is known in the art to be useful as taught by Bara. As such the recited claims of the copending applications are not mutually exclusive and thus not patentably distinct.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

Art Unit: 1617

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 17, 19-42, 49, 70-95 and 99 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanna et al. (US Patent No. 5,843,417).

Claims 1, 17, 19-42, 49 and 70-95 of the instant application claim a water-in-oil emulsion (W/O) comprising a fatty phase, an aqueous phase, at least one surfactant chosen from C₈-C₃₃ alkyl dimethicone copolyols, and at least one other dimethicone copolyol (5% to 10%), a hydrophobic coated pigment, at least one volatile hydrocarbon oil, and at least one volatile oil.

Hanna et al. teach, in col. 1 line 48 to col. 2 line 20, a water-in-oil (W/O) emulsion, wherein the oil is preferably a C₁₀-C₁₄ saturated, linear, or branched hydrocarbon (such as isododecane). Mixtures of hydrocarbon oils can be used. The W/O emulsion contains solid particles, preferably pigment particles. The pigment particles may be coated with a hydrophobic coating. The W/O emulsion preferably contains at least two different types of surfactants, a water-soluble and/or water-dispersible polymer, a gelator (optionally with an activator), and additional ingredients such as moisturizers, light diffusers, fillers, salts, emulsifiers, preservatives, fragrances etc.

Art Unit: 1617

Hanna et al. teach, in col. 2 lines 37-49, the W/O preferably contains from 20-55% water by weight. In col. 2 line 62 to col. 3 line 40, Hanna et al. teach that the W/O preferably contains 10-55% oil wherein the oil preferably is a hydrocarbon-based oil (such as isododecane), additional oils may be present including silicone oils, including volatile silicone oils (such as linear and cyclic silicone oils).

Hanna et al. teach, in col. 3 line 45 to col. 4 line 50, that the W/O preferably contains 1-20% of solid particles including pigment particles and others. Suitable pigments include red, yellow and black iron oxides; titanium dioxide, zinc oxide; zinc stearate; and boron nitride. Preferably the pigment particles are coated with a hydrophobic material. The hydrophobic coating includes hydrophobic alcohol metal acids (such as isopropyl titanium triisostearate), soaps (such as sodium stearate), and fluorinated oils. The coatings are either adsorbed onto and/or adsorbed into the particles.

Hanna et al. teach, in col. 4 line 56 to col. 5 line 33, that the W/O preferably contain one or more surfactants. Examples of suitable oil surfactants include dimethicone copolyol, laurylmethicone copolyol, glyceryl stearate, beeswax, cetyl dimethicone copolyol, polyglyceryl-4-isostearate and hexyl laurate and that of course, mixtures of useful oil surfactants may be used. The amount of oil surfactant(s) useful in the W/O is from 5-15%.

In col. 6 lines 8-50, Hanna et al. teach that the W/O preferably comprises a gelator (such as clays, bentones, hectorites etc...) in amounts from 0.1-10% by weight, a moisturizer (such as propylene glycol) in amounts of from 0.1-10% by weight, light

Art Unit: 1617

diffusers (such as nylon-12) in amounts from 0.1-10% by weight, fillers (such as talc etc...) in amounts from 0.1-10% by weight, salts (such as sodium chloride, magnesium sulfate etc...) in amounts from 0.1-10% by weight, and preservatives (such as methylparaben, diazolidinyl urea and butyl paraben) in amounts of from 0.1-10% by weight.

Hanna et al. do not specifically teach that the W/O emulsion contains a C₈-C₂₂ alkyl dimethicone copolyol and another dimethicone copolyol wherein the dimethicone copolyol is present in an amount ranging from 5% to 10% by weight. Hanna et al. do not specifically teach the exact ranges of components as claimed in the instant application. Hanna et al. do not specifically teach the viscosity of the foundation as claimed in claims 94 and 95.

As described above, Hanna et al. teach that the W/O emulsions preferably contain one or more surfactants to stabilize the emulsion and examples of the oil surfactant include dimethicone copolyol, the C₈-C₂₂ alkyl dimethicone copolyol, cetyl dimethicone copolyol, etc. (see column 4 lines 56-57 and column 5 lines 3-6). Furthermore, Hanna et al. teach that of course, mixtures of useful oil surfactants may be used (see column 5 lines 6-7). Hanna et al. also teach that the amount of oil surfactant useful in the W/O emulsion is from 5-15 wt. %. As such Hanna et al. meet the limitations of instant claim 1 since Hanna et al. teach that mixtures of oil surfactants (e.g. dimethicone copolyol and cetyl dimethicone copolyol) are useful and that the amount of oil surfactant is between 5 and 15 wt. %. As such, dimethicone copolyol and cetyl dimethicone copolyol can be added up to 15 wt. % which could be 5% dimethicone

Art Unit: 1617

copolyol and 5% cetyl dimethicone copolyol or 10% dimethicone copolyol and 5% cetyl dimethicone copolyol, etc.

Although Hanna et al. do not teach the specific amounts of each of the components, Hanna et al. teach overlapping ranges as claimed in the instant application. As such, it is within the skill of an ordinary skilled artisan to adjust the amounts of components within a composition so that the desired composition is obtained.

Hanna et al. teach, in col. 7 lines 15-20, that the emulsion can vary in consistency from liquid to a paste to a solid depending upon the water amount, etc. It is within the ability of one ordinary skill in the art to adjust the viscosity of a formulation to achieve nearly any desired viscosity based upon the consistency and properties of the desired formulation.

The examiner respectfully points out the following from MPEP 2144.05: “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955); see also *Peterson*, 315 F.3d at 1330, 65 USPQ2d at 1382 (“The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages.”); *In re Hoeschele*, 406 F.2d 1403, 160 USPQ 809 (CCPA 1969); *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S.

Art Unit: 1617

975 (1989); *In re Kulling*, 897 F.2d 1147, 14 USPQ2d 1056 (Fed.Cir. 1990); and *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997).

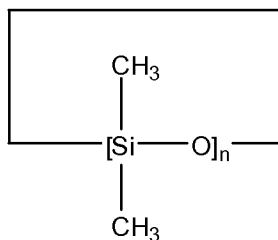
Claims 43-47 and 53-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanna et al. as applied to claims 1, 17, 19-42, 49, 70-95 and 99 above, and further in view of Elm et al. (US Patent No. 4,552,753), and as evidenced by the Aldrich Catalog 2003-2004.

Claims 43-47 and 53-69 claim a W/O foundation as claimed in instant claim 1, described above, wherein the volatile silicone oils are chosen from silicone oils having a flash point ranging from 40° C to 102° C.

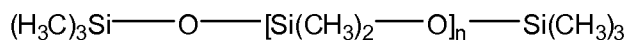
Hanna et al. is as set forth above.

Hanna et al. do not teach particular volatile linear and/or cyclic silicone oils as claimed, nor the flash points of said volatile silicone oils.

Elm et al. teach, in col. 2 lines 30-65, that volatile silicone oils can be linear or cyclic, with preferred silicone oils having from about 3 to about 9 silicon atoms. Cyclic volatile silicones include those of the following formula:



wherein n=3 to 7. Linear volatile silicone oils include those of the following formula:



Wherein n= 1 to 7.

The formulas thus encompass the compounds octamethylcyclotetrasiloxane (FP=60°C, Aldrich), decamethylcyclopentasiloxane (FP=72°C, Aldrich), dodecamethylcyclohexasiloxane, decamethyltetrasiloxane (FP=64°C, Aldrich), dodecamethylpentasiloxane (FP=86°C, Aldrich) and others.

It would have been obvious to one of ordinary skill in the art at the time the invention was made that the broadly disclosed volatile silicone oils of Hanna et al. included the volatile silicone oils as described by Elm et al. and as evidenced by the Aldrich Catalog. One would be motivated to choose any of the particular cyclic or linear volatile silicone oils as the general characteristics of the volatile silicone oils are similar and it would be a matter of routine optimization to choose which of the volatile silicone oils would best fit any particular formulation. One would expect a reasonable chance of success as Hanna et al. describe broadly that linear and cyclic silicone oils are suitable for use in the invention.

Claims 48, 50-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanna et al. as applied to claims 1, 17, 19-42, 49, 70-95 and 99 above, and further in view of Bara (US Patent No. 6,224,851).

Claims 48 and 50-52 of the instant application claim a W/O foundation as claimed in instant claim 1, described above, wherein the volatile fluorinated oils are chosen from at least nonafluoroethoxybutane, nonafluoromethoxybutane, decafluoropentane, tetradecafluorohexane, and dodecafluoropentane.

Hanna et al. is as set forth above.

Hanna et al. do not teach particular volatile fluorinated oils as claimed.

Bara teaches, in the abstract, make-up and sunscreen cosmetic compositions comprising at least one polyorganohalogen solvent wherein the halogen is fluorine. In col. 3 lines 3-17, Bara teaches that preferred fluoroalkyl and heterofluoroalkyl compounds include methoxynonafluorobutane, ethoxynonafluorobutane, dodecafluoropentane and tetradecafluorohexane. Bara teaches in col. 1 line 53 to col. 2 line 18, that volatile polyorganohalogen solvents (wherein the halogen is fluorine) are safe as they have no flash point, allowing for the compositions to be prepared using elevated temperatures; additionally they allow for higher concentrations of non-volatile fluorinated derivatives to be incorporated into the compositions. Further the volatile fluorinated solvents have better anti-transfer properties than traditional transfer-resistant make-up components.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the particular fluorinated solvents of Bara in the formulations of Hanna et al. as Hanna et al. disclose the use of fluorinated oils in general and Bara teaches that volatile fluorinated solvents have better anti-transfer properties when utilized in cosmetic compositions. One would expect a reasonable chance of success

Art Unit: 1617

as Hanna et al. describe broadly that volatile fluorinated oils are suitable for use in the invention.

Conclusions

Claims 1, 17, 19-95 and 99 are rejected. Claims 2-16 and 96-98 are withdrawn. Claim 18 is canceled. No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KARA R. MCMILLIAN whose telephone number is (571)270-5236. The examiner can normally be reached on Monday-Thursday from 8:30 am- 6:00 pm and every other Friday from 8:30 am- 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (571)272-0629. The fax phone

Art Unit: 1617

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kara R. McMillian/
Examiner, Art Unit 1617

KRM

/SREENI PADMANABHAN/

Supervisory Patent Examiner, Art Unit 1617